As the Canadian Government discussed in its amicus briefs below, these concerns are central here because the BlackBerry system's critical component, the Network Control Center, is subject to Canada's patent laws. The presumption against extraterritoriality operates precisely to "protect against unintended clashes between our laws and those of other nations which could result in international discord." *Aramco*, 499 U.S. at 248. Yet, NTP's opposition wholly ignores the fundamental encroachment on comity of the opinion below. The international sensitivities presented by this case further counsel this Court's review.

3. This Case Falls Squarely Within This Court's Jurisdiction And Offers An Ideal Vehicle To Resolve The Question Presented. There is no bar to this Court's exercise of jurisdiction in this case. NTP concedes "that this Court has jurisdiction on the ground recited in RIM's petition." Opp. at 1. Indeed, contrary to its bizarre "alert" to this Court, *id.*, at NTP's urging, the Federal Circuit exercised appellate jurisdiction despite a settlement dispute between the parties, and then on remand, again at NTP's urging, the district court ruled that there is no enforceable settlement between the parties, *see* Pet. at 10 n. 3 & App. 176a. Now the district court has ordered briefing on damages and the entry of a permanent injunction.

NTP's other objections to review are likewise distractions that are wholly without merit.[5] The Federal

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[5] NTP's misleading and irrelevant assertions regarding changing litigation positions are not well taken. RIM argued below, as it does now, that *Decca* is distinguishable since the situs of the control center in the BlackBerry system is outside the United States. NTP's suggestion of waiver is belied by its failure to actually identify any such waiver. Opp. at 27-28. Its assertion that further percolation is somehow necessary here is unfounded. This not only is a case where there is cause for concern regarding how courts in the future may interpret Federal Circuit precedent, Opp. at 27, but also where the Federal Circuit has blatantly

(footnote continued on next page)

Circuit held that RIM could not infringe the method claims under *any* of the subsections of § 271, and NTP has not cross-petitioned for review of that determination. For similar reasons, none of those other subsections could or do provide an alternate ground of affirmance as to the system claims. Thus, NTP's assertion that the Court should not grant review merely because § 271 has multiple provisions, some of which were not specifically addressed in the opinion below, is without merit. Opp. at 5-6, 29. Similarly, NTP's argument that the Court should not grant review because RIM did not appeal findings of inducement or contributory infringement is wholly without merit. Indeed, as RIM argued on appeal, it is blackletter patent law that there cannot be a finding of such secondary liability where there is no underlying act of infringement. *See* Opp. at 2, 12.

Finally, NTP's contention that granting this petition would have no effect because the question presented does not encompass the findings of liability under the '592 patent is simply wrong. Opp. at 3, 29-30. The asserted "system" claims, including the '592 patent claims, require specific acts that NTP alleges are performed by the Network Control Center in Canada. Although the '592 claims do not use the term "interface," they include limitations that occur through, and under control of, the Network Control Center. This Court's decision on the merits would thereby control the ultimate resolution of the case.

CONCLUSION

The petition for a writ of certiorari should be granted.

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misapplied this Court's precedent regarding extraterritoriality and, in so doing, departed from the company of its sister circuits.

Respectfully submitted,

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IN THE

Supreme Court of the United States

RESEARCH IN MOTION, LTD.,

Petitioner,

v.

NTP, INC.,

Respondent.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

MOTION FOR LEAVE TO FILE BRIEF AS AMICUS CURIAE AND BRIEF FOR THE GOVERNMENT OF CANADA AS AMICUS CURIAE IN SUPPORT OF THE PETITION

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MOTION OF THE GOVERNMENT OF CANADA FOR LEAVE TO FILE BRIEF AS AMICUS CURIAE

The Government of Canada respectfully moves for leave to file the attached brief as amicus curiae in this case. Counsel for petitioner has consented to the filing of this brief, but counsel for respondent has conditioned consideration of its consent on terms unacceptable to Canada.

The question in this case relates to the territorial scope of the U.S. patent laws. Specifically, the case presents the question whether a transnational telecommunications system with a component in Canada (the BlackBerry system) is used "within the United States" for purposes of section 271(a) of the Patent Act. The decision below, with its emphasis on the location of

the user rather than the location of the components of the system and its distinction between method and use claims, presents a new formulation of the territorial scope of section 271(a). Canada believes that fostering and protecting innovation requires clarity and predictability in the application of domestic patent laws.

As the sovereign in whose territory the BlackBerry system is partially located, a key U.S. trading partner, a party to international treaties governing intellectual property rights, and a user of the BlackBerry system, the Government of Canada has a strong interest in this case and believes that the Court would benefit from the views expressed herein.

Respectfully submitted,

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BRIEF FOR THE GOVERNMENT OF CANADA AS AMICUS CURIAE IN SUPPORT OF THE PETITION

INTEREST OF THE AMICUS CURIAE

The Government of Canada expresses its appreciation to the Court for the opportunity to express its views, as amicus curiae, in connection with the Petition for a Writ of Certiorari filed in this case.[1] Among the interests that the Government of Canada has in this case are the following.

[1] Pursuant to Supreme Court Rule 37.6, counsel for a party neither authored this brief in whole or in part, and no person or entity

(footnote continued on next page)

First, the Government of Canada has a strong interest in the protection of intellectual property rights and in fostering the innovation that forms the basis of, and is promoted by, such rights. Canada recognizes that compliance with applicable intellectual property laws is best encouraged and enabled where the law is clear and predictable respecting liabilities that may arise. Clarity and predictability are especially important when, as in this case, technology in one national jurisdiction is alleged to infringe intellectual property rights in another.

Second, like the United States, Canada is a party to the Paris Convention for the Protection of Industrial Property, opened for signature March 20, 1883, as revised at Stockholm July 14, 1967, 21 U.S.T. 1583, 828 U.N.T.S. 305. Both countries are committed participants to the international intellectual property law regime that has arisen from the Paris Convention. The Paris Convention did not contemplate the transnational technology issue presented in this case. Just as domestic intellectual property law must be re-interpreted to address novel, unanticipated situations presented by new technology, so must international law. Whether and how the decision in this case affects the inter-relationship between U.S. domestic law and the Paris Convention is of direct interest to Canada.

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other than the Government of Canada made a monetary contribution to the preparation or submission of this brief. Although not relevant to its interests in this case, the Government of Canada notes that through Industry Canada it has extended financial assistance to petitioner through the Technology Partnerships Canada program. As of December 30, 2005, Industry Canada's outstanding assistance to petitioner totaled approximately $34,000,000 (Cdn). Earlier assistance of approximately $5.7 million (Cdn) has been satisfied in full.

Third, the unique and important trade relationship between Canada and the United States also forms a basis for Canada's interest in this case. Canada and the United States share the largest bilateral trading relationship in the world, with trade in goods and services of over $1.2 billion crossing the border every day. As the economies of Canada and the United States grow increasingly interdependent, advances in system, network, and communication technologies can be expected to give rise to increasing numbers of private disputes seeking to enforce intellectual property rights in respect of technology that simultaneously is located and operates in more than one national jurisdiction. Here, the "Relay" component of petitioner's wireless BlackBerry network is located in Canada. Pet. App. 7a.

Finally, like the Government of the United States, the Government of Canada has come to rely heavily on the BlackBerry system. An injunction barring BlackBerry use in the United States may soon issue from the United States District Court for the Eastern District of Virginia. Such an injunction would disrupt communications with and among Canada's embassy, consular offices, and other diplomatic offices in the United States, just as it could potentially affect communications with and among the offices of the U.S. government. The Government of the United States, however, benefits from a statutory exemption (28 U.S.C. § 1498(a)) that likely would allow it to continue to rely on the BlackBerry system in the United States. The statutory exemption, however, does not apply to foreign governments, such as the Government of Canada. Given these potential repercussions, the Government of Canada also has a practical interest in seeing authoritative answers to the novel legal issues that this case presents, particularly in light of the recent determination by the U.S. Patent and Trademark Office that calls into question the validity of the underlying patents on which this entire legal struggle has been predicated.

INTRODUCTION

The Government of Canada supports review by the Court because authoritative clarification of the legal issues that this case presents would be valuable both within and outside the United States. Issues affecting transnational technology and communications systems will undoubtedly arise with increasing frequency in both Canada and the United States. Because the issues of statutory construction presented in the petition will have significant consequences for the use of new and developing technologies in both Canada and the United States, Canada is of the view that Supreme Court review of this statutory provision would provide timely and needed certainty with respect to its application.[2]

The technology at issue in this patent dispute integrates existing electronic mail systems with radio frequency wireless communication systems to enable a mobile user to receive email over a wireless network. Pet. App. 3a. The petitioner, Research in Motion, Ltd. ("RIM"), a Canadian corporation, operates such a system under the BlackBerry trademark *Id.* at 6a. Respondent, NTP, Inc., alleges that the BlackBerry system infringes its U.S. patents. In the district court proceeding, a jury found for NTP. *See id.* at 2a. The Federal Circuit affirmed the district court's judgment of infringement in part, reversed in part, and vacated and remanded in part.

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[2] Canada continues to believe, as stated in amicus briefs filed with the Federal Circuit, that the issues in this case merit explicit and authoritative consideration of comity and treaties. In this connection, however, we note that the petition's representation that Canada filed the amicus briefs to "protest" the Federal Circuit's "extraterritorial application of § 271(a) to the transnational BlackBerry system," Pet. at 27 n.11, overstates Canada's position. The same may be said of the characterization of Canada's position in petitioner's reply brief at page 9.

Section 271(a) of the Patent Act defines infringement to include the unauthorized use of a patented invention "within the United States." 35 U.S.C. § 271(a). The Federal Circuit concluded that the BlackBerry system is used "within the United States" even though the BlackBerry Relay is located in Canada. Pet. App. 55a-56a. Email messages sent on the BlackBerry system "travel[] through the BlackBerry Relay, where [they are] translated and routed from the processors in the user's email system to a partner wireless network." *Id.* at 8a. Petitioner refers to the Relay as the "Network Control Center" of the BlackBerry system and characterizes it as the system's "indispensable electronic brain." Pet. at 4.

Notwithstanding the location of the Relay in Canada, the Federal Circuit held that the BlackBerry system is used "within the United States" because "RIM's customers located within the United States controlled the transmission of the originated information and also benefited from such an exchange of information." Pet. App. 56a.

The statutory construction issue this case presents arises in the context of a statute that historically has been confined in its territorial reach. When it has had occasion to consider section 271(a), the Court has construed it narrowly and has emphasized its limited territorial scope. The transnational technologies that now exist and that are under development were not contemplated when section 271(a) was enacted. Transnational technologies present novel issues regarding when a technology can be considered to be sufficiently used within a national territory that it falls within the jurisdiction of that country's patent laws. Depending on the facts of a particular case, the application of domestic intellectual property laws to a transna-

tional technology may raise issues of international law, conflicts of laws, and comity.[3]

The Federal Circuit's interpretation of section 271(a), with its emphasis on the location of the users rather than the components of a system and its distinction between "method" claims and "system" claims, represents a novel application of the statute. The Federal Circuit's interpretation has implications for the international intellectual property law regime and, depending on the factual setting of a given patent dispute, could raise issues of overlapping national jurisdiction.

The issues in this case, involving as they do the application of domestic law to technology systems that have a transnational dimension, merit a close, explicit, authoritative discussion, which was not undertaken by the Federal Circuit and which the Court is uniquely situated to provide.

The serious consequences of a finding of infringement also warrant the Court's review of the extent of U.S. patent infringement jurisdiction. The Federal Circuit has adopted the position that a permanent injunction usually issues upon the finding of an infringement. *See MercExchange, LLC v. eBay Inc.*, 401 F.3d 1323 (Fed. Cir. 2005), *cert. granted*, 163 L. Ed 2d 567, 2005 U.S. LEXIS 8572, 74 U.S.L.W. 3321 (U.S. 2005). This is the case even where the validity of the patents has been called into question by an adverse preliminary determination by the Patent and Trademark Office, as they recently have been here, and where the patent claimant does not practice the patent, as is the case with NTP. Given the scale of these

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[3] In *Menashe Business Mercantile Ltd. v. William Hill Organization, Ltd.*, the United Kingdom exercised patent jurisdiction over a transnational technology. [2002] E.W.J. No. 5413, E.W.C.A. Civ. 1702 (Court of Appeals, Civ. Div., Nov. 28, 2002), [2003] All E.R. 279 (C.A. 2002). As with the decision below, the *Menashe* decision also did not discuss international law, conflicts of law, or comity.